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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/594,793

09/10/2008

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EXAMINER

ADKINS, CHINESSA T

ART UNIT

PAPER NUMBER

1788

MAIL DATE

DELIVERY MODE

03/19/2012

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/594,793 | <b>Applicant(s)</b><br>SUGA ET AL. |  |
|                              | <b>Examiner</b><br>CHINESSA ADKINS   | <b>Art Unit</b><br>1788            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2012.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5) ☒ Claim(s) 1-3,6,7 and 13-16 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1-3,6,7 and 13-16 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-302)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. Claims 1-3, 6, 7 and 13-16 are pending in the application. Claims 4, 5 and 8-12 have been cancelled.
3. Amendments to the claim 1, filed on 3/9/2012, have been entered in the above-identified application.

### ***WITHDRAWN REJECTIONS***

4. The 35 U.S.C. §102/103 rejection of claims 1-16 over Mori et al. (US Patent No. 6,326,086), made of record in the office action mailed 12/9/2011, page 2, paragraph 3 has been withdrawn due to Applicant's argument in the response filed 3/9/2012.

### ***REJECTIONS***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

6. Claims 1-3, 6, 7 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US Patent No. 6,326,086) in view of Yanagase et al. (US Patent No. 6,630,246).

7. Regarding claims 1-3, 7, 13-15, Mori et al. teaches a laminate decorative sheet for simultaneous decoration and injection molding (col. 1, lines 8-16, 59-67, col. 2, lines 1-5) which comprises a base film and a decorative layer provided on the base film (col. 1, lines 59-67, col. 2, lines 1-4), the decorative sheet has an elongation at break as measured at 110 °C of not less than 150% (col. 8, lines 25-44), wherein the base film is formed of an acrylic resin composition containing polymethacrylate or a derivative thereof as a primary component (col. 8, lines 46-51), wherein the base film includes an acrylic rubber (col. 8, lines 45-51). While the ambient temperature is set to 110 °C, Mori et al. teaches wherein the suitable temperature range for measurement is 110 to 130 °C since this is the temperature suitable for three-dimensionally performing a film (col. 8, lines 13-18).

8. Mori et al. fails to teach wherein a content of the rubber material included in the base film is 3 to 30 parts by mass based on 100 parts by mass of a base resin also included in the base film. However, Yanagase et al. teaches a decorative sheet for simultaneous decoration and injection molding, which is a laminate and which comprises a base sheet and at least a decorative layer provided on the base sheet wherein the base sheet is formed of an acrylic resin and contains a rubber component (col. 2, lines 20-30, col. 6, lines 46-60, col. 21, lines 15-22). Yanagase et al. teaches

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wherein an acrylic resin sheet with a rubber component is included in the base sheet for its compatibility with the resin composition A. Resin A comprises an acrylic rubber in the range of 0.01-20 parts by weight per 100 parts by weight of the resin (col. 5, lines 45-47). It is the necessary compatibility between the base sheet comprising a rubber component and resin A which suggests that base sheet A would comprise acrylic rubber component in 0.01-20 parts by weight per 100 parts by weight of the base resin as well given that the base sheet is a stretchable material (col. 6, lines 45-60) and the required amount of rubber component is related to reducing the brittleness of the material (col. 5, lines 45-55).

9. One of ordinary skill in the art would deem the elongation at break as measured at 25 °C of 3 to 10%, in both a flow direction during formation of the base film and a direction perpendicular to the flow direction, and 40 °C of 10 to 20% of an acrylic resin an obvious property of the resulting material of Mori et al., as modified by Yanagase et al. because it possesses all the other claimed properties within the same structure. The goal of both Mori et al. and Yanagase et al. is to produce a highly stretchable material with excellent design properties which indicates that the elongation at break as measured at 25 and 40 °C, would be an obvious property since like materials yield like properties.

10. Mori et al. and Yanagase et al. are analogous because they both disclose a decorative sheet for simultaneous decoration and injection molding comprising a base film and a decorative layer wherein the base film is an acrylic resin composition and

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includes an acrylic rubber, wherein the sheet is suitable for use as automobile interior materials.

11. It would have been obvious to a person of the ordinary skill in the art at the time of the invention to use the rubber content of Yanagase et al. in combination with the decorative sheet of Mori et al. so that the effect of the rubber addition may be achieved and avoid reducing the film strength which would produce a brittle film and be subject to breaking during processing (Yanagase et al., col. 5, lines 45-55).

12. Regarding claim 6, Mori et al. teaches a decorated resin molded product comprising a resin molding and a decorated sheet wherein the decorative layer of the decorative sheet is bonded to the molding (col. 1, lines 59-67, col. 2, lines 1-5).

13. Regarding claim 16, Mori et al. teaches a decorative sheet for simultaneous decoration and injection molding (col. 1, lines 8-16) wherein the decorative sheet further comprises an adhesive layer such that the adhesive layer and base film sandwich the decorative layer (col. 13, lines 61-65, col. 14, lines 27-32, Fig. 6).

### ***Response to Arguments***

14. Applicant's arguments filed 3/9/2012, with respect to the rejection of claims 1-16 under 35 USC 102/103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made over Mori et al. (US Patent No. 6,326,086) in view of Yanagase et al. (US Patent No. 6,630,246). Applicant's arguments are moot because the arguments do

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not apply to Mori et al. as modified by Yaganese et al. being used in the current rejection.

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHINESSA ADKINS whose telephone number is (571)270-5543. The examiner can normally be reached on Monday - Friday; 8:00 - 4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alicia Chevalier can be reached on 571-272-1490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. A./

Chinessa Adkins

Examiner, Art Unit 1788

3/14/2012

/Alicia Chevalier/

Supervisory Patent Examiner, Art Unit 1788